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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,659	01/03/2002	Wei Wang	DX0589K1B	9741

7590 03/11/2003

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EXAMINER
KEMMERER, ELIZABETH

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,659	WANG ET AL.	
	Examiner	Art Unit	
	Elizabeth C. Kemmerer, Ph.D.	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 20 June 2002 .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 23-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 23-42 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 23-26, in part, drawn to polypeptides corresponding to SEQ ID NO: 2, classified in class 530, subclass 350.

II. Claims 23-26, in part, drawn to polypeptides corresponding to SEQ ID NO: 4, classified in class 530, subclass 350.

III. Claims 27-32, in part, drawn to polynucleotides encoding a SEQ ID NO: 2 polypeptide, vectors and host cells comprising same, and methods of recombinantly producing the encoded polypeptide, classified in class 435, subclass 69.1.

IV. Claims 27-32, in part, drawn to polynucleotides encoding a SEQ ID NO: 4 polypeptide, vectors and host cells comprising same, and methods of recombinantly producing the encoded polypeptide, classified in class 435, subclass 69.1.

V. Claims 33-38, in part, drawn to antibodies that bind SEQ ID NO: 2, classified in class 530, subclass 387.1.

VI. Claims 33-38, in part, drawn to antibodies that bind SEQ ID NO: 4, classified in class 435, subclass 387.1.

VII. Claims 39-42, in part, drawn to methods of administering antibodies that bind SEQ ID NO: 2, classified in class 424, subclass 130.1.

VIII. Claims 39-42, in part, drawn to methods of administering antibodies that bind SEQ ID NO: 4, classified in class 424, subclass 130.1.

The inventions are distinct, each from the other because of the following reasons:

Each of the following pairs of inventions are independent and distinct: I/II, III/IV, V/VI, VII/VIII. The reason they are independent and distinct is that the first invention of each pair requires search and consideration of SE QID NO: 2, whereas the second invention of each pair requires search and consideration of SEQ ID NO: 4. These are non-overlapping searches and require a separate search of the literature and sequence databases. Therefore, search and consideration of Inventions pertaining to both SEQ ID NO; 2 and SEQ ID NO: 4 would be an undue search burden.

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I-VI are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Further, the proteins of Groups I and II can be prepared by processes which are materially different from recombinant DNA expression of Groups III and IV, such as by chemical synthesis, or by isolation and purification from natural sources. Additionally, the DNAs of Groups III and IV can be used other than to make the proteins of Groups I and II, such in gene therapy or as probes in nucleic acid hybridization assays. The proteins of Groups I and II can be used in materially different methods other than to make the antibodies of Groups V and

VI, such as in therapeutic or diagnostic methods (e.g., in screening). Finally, although the antibodies of Group V and VI can be used to obtain the DNAs of Groups III and IV, they can also be used in materially different methods, such as in various diagnostic (e.g., as a probe in immunoassays or immunochromatography), or therapeutic methods.

Inventions V and VII, and Invention VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies can be used to isolate DNA clones in expression cloning. Also, the antibodies can potentially be administered therapeutically.

The following pairs of Inventions are unrelated: I/VII, I/VIII, II/VII, II/VIII, III/VII, III/VIII, IV/VII, IV/VIII, V/VIII, VI/VII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the product of each Inventions pair is not required by the method of each Invention pair.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D. whose telephone number is (703) 308-2673. The examiner can normally be reached on Mon. - Thurs., 6:30 to 4:00, and alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne L. Eyler, Ph.D. can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

ECK
March 10, 2003